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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONNIE T. MARSHALL and MASOOD GARAH

Appeal 2009-010116
Application 09/609,073
Technology Center 3700

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 2-19 and 38-48. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). We affirm.

Appellants' invention is directed to interactive wagering systems and methods, and particularly to wagering systems and methods that allow users to place wagers on live wagering events (Spec. 1, ll. 8-11). Claim 19 is illustrative:

19. A method for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment, comprising:
allowing the user to create and place a wager for a given race;
automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race; and
recording the given race.

Appellants appeal the following rejections:

Claims 2-11 and 14-19 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 2-9, 11-19 and 38-48 are rejected under 35 U.S.C. § 102(e) as anticipated by Brenner (U.S. 5,830,068, iss. Nov. 3, 1998 ("Brenner '068")).

Claims 2-7, 11-19, and 38-48 are rejected on the ground of nonstatutory nonobviousness-type double patenting over claims 1-5, 17, 37-41, 46 and 49 of Brenner (U.S. 6,004,211, iss. Dec. 21, 1999 ("Brenner '211)).

Claim 39 is rejected on the ground of nonstatutory obviousness-type double patenting over claim 37 of Brenner '211.

Claims 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 4, and 5 of Brenner '211.

Claim 10 is rejected under 35 U.S.C. § 103(a) as unpatentable over Brenner '068.

ISSUES

Did the Examiner err in rejecting claims 2-11 and 14-19 under 35 U.S.C. § 101 because the claims are tied to a particular machine and transform an article to a different state or thing?

Did the Examiner err in rejecting the claim 19 under 35 U.S.C. § 103(e) because Brenner '068 fails to show or suggest automatically providing a user with an opportunity to record a given race in response to placing a wager on the given race?

FACTUAL FINDINGS

We adopt the specific Examiner's findings found at the referenced portion of the Answer as our own. Ans. 6-8, 10, 14.

ANALYSIS

Patentable subject matter

We do not sustain the 35 U.S.C. § 101 rejection. Although the law on patent-eligibility for process claims under § 101 has undergone significant clarification since the mailing of the Answer in 2008, the machine-or-transformation test is still a factor that is weighed in determining patent eligibility of a process claim. *See* Interim Guidance for Determining Subject

Matter Eligibility for Process Claims in View of *Bilski v. Kappos*, 75 Fed. Reg. 43,922, 43,926 (July 27, 2010).

We agree with Appellants that the claims are tied to machine, i.e., user equipment. The Examiner is correct that recitations in the preamble that do not limit the body of the claim and only state the invention's purpose relate only to the intended use of the invention. See *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010) (internal quotations and citation omitted) (noting that a preamble that “merely gives a descriptive name to the set of limitations in the body of the claim that completely set[s] forth the invention” has no separate limiting effect). We do not agree with the Examiner that the recitations that tie the claims to a machine occur only in the preamble of the claims. Although “user equipment” appears only in the preamble of the claims, the body of the claims also includes the step of “recording.” This recording is done by the user on the user equipment. As such, claim 19, and claims 2-7, 11 and 14-18 dependent thereon, are tied to a machine and thus these claims recite patentable subject matter.

Anticipation

Appellants' argument that Brenner '068 does not disclose automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race is not persuasive. App. Br. 7-10. We agree with the Examiner that the word “opportunity” when broadly construed means a situation or condition favorable for attainment of a goal. Ans. 5. We also agree that because the user has the opportunity to select “Other Races” or “Tape/VCR” and choose to record the race, Brenner '068 meets this recitation in the claims. Ans. 17. Therefore,

we sustain the rejection of claim 3 and of claims 4-7, 9, 11-19 and 38-48 which Appellants did not separately argue.

We agree with Appellants that Brenner '068 does not allow a user to select "yes" or "no" in response to an option to record a race. App. Br. 10. Brenner '068 allows a user to select the "Tape/VCR" option or not select the "Tape/VCR" option, but there is no disclosure that the user is allowed to select "yes" or "no." Therefore, we reverse the rejection of claim 2.

We also agree with Appellants that Brenner '068 does not disclose that the previously recorded races in the personal archive are listed with their corresponding track name. App. Br. 11-12. The Examiner relies on Figures 49 and 50 to teach this subject matter. Ans. 13. Figures 49 and 50 depict how a user can check the results of a race and tape or record the race. However, Figures 49 and 50 do not depict recorded races in a personal archive but rather screens that are presented to the user by the system. Therefore, we reverse the rejection of claim 8.

Obviousness-type Double Patenting

The key question in any obviousness double patenting analysis is: "Does any claim in the application define merely an obvious variation of an invention claimed in the patent asserted as supporting double patenting?" *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1278 (Fed. Cir. 1992) (discussing *In re Vogel*, 422 F.2d 438 (CCPA 1970)). As stated by our reviewing court in *In re Braat*, 937 F.2d 589, 592-93 (Fed. Cir. 1991) (citation omitted):

Obviousness-type double patenting is a judicially created doctrine intended to prevent *improper* timewise extension of the patent right by prohibiting the issuance of claims in a

second patent which are not “patentably distinct” from the claims of a first patent.

An analysis analogous to an obviousness analysis under 35 U.S.C. § 103(a) comes into play during the step of determining the obviousness of the “difference” between the claimed invention and the patented invention. *See Studiengesellschaft Kohle mbH v. N. Petrochemical Co.*, 784 F.2d 351, 355 (Fed. Cir. 1986); *In re Longi*, 759 F.2d 887, 892-93 (Fed. Cir. 1985). The disclosure of a patent cited in support of a double patenting rejection cannot be used as if it were prior art, even where the disclosure is found in the claims. *In re Braat*, 937 F.2d at 594 n.5. “It is the claims, not the specification, that define an invention. . . . And it is the claims that are compared when assessing double patenting.” *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 943 (Fed. Cir. 1992). However, the disclosure of a patent may be used to learn the meaning of terms and in “interpreting the coverage of [a] claim.” *Vogel*, 422 F.2d at 441.

Appellants’ argument that obvious-type double patenting rejections must be based on references that are not available as prior art under 35 U.S.C. §§ 102 or 103 are also not persuasive. Appellants cite several cases to support this statement. We have reviewed the cited cases do not find support for Appellants’ statement of the law in these cases.

It is true, as explained above, that in an obviousness-type double patenting rejection, the disclosure of the patent on which the rejection is based is not used as prior art. Rather, it is the claims of the reference that form the basis of the rejection. Appellants have not directed our attention to case law that states that the claims of a prior art reference that is available as prior art cannot be the basis of a double patenting rejection.

Appellants' argument that the claim 37 of Brenner is patentably distinct because the appealed claims require automatically providing the user an opportunity to record a race in response to the user placing the wager is not persuasive. App. Br. 15. As noted above, we agree with the Examiner that the word "opportunity" when broadly construed means a situation or condition favorable for attainment of a goal. Ans. 5. Claim 37 recites that the user is provided an opportunity to request the video clip of the race. We agree with the Examiner that once the user receives the video clip of the race, the user has an opportunity to record the race. Thus, we sustain the double-patenting rejection of claim 2, and of claims 3-7, 11-19, and 38-48 which Appellants did not separately argue.

We sustain the rejection of claims 8-10 under the judicially created doctrine of obviousness-type double patenting over claims 1, 4 and 5 of Brenner '211. Appellants make the same argument in regard to this double patenting rejection as was made to the double patenting rejection discussed above. App. Br. 13-15. Claim 1 of Brenner '211, like claim 37, recites that the user is provided an opportunity to request a video clip of the race. We thus sustain this rejection for the same reasons given above for claim 2.

Obviousness

Appellants' argument that there is no motivation to modify Brenner '068 so that the previously recorded races in the personal archives are listed with their corresponding date is also unpersuasive. App. Br. 12. We agree with the Examiner that at the time of the invention it was known to list a file type with a corresponding date and that modifying the system of Brenner '068 to include a date for each race recorded is no more than the use of a

known method to yield predictable results. Ans. 20. Therefore, we sustain this rejection.

DECISION

We reverse the rejection of claims 2-11 and 14-19 under 35 U.S.C. § 101.

We affirm the rejection of claims 3-7, 11-19 and 38-48 under 35 U.S.C. § 102(e).

We reverse the rejection of claims 2 and 8 under 35 U.S.C. § 102(e).

We affirm the rejection of claims 2-9, 11-19, and 38-48 under the judicially created doctrine of double patenting.

We affirm the rejection of claim 10 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1).

AFFIRMED